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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. 03-772

In re Application of Somberg <i>et al.</i>)	
)	
Application No.: 10/655,878)	Group Art Unit: 1657
)	
Filing Date: September 5, 2003)	Confirmation No.: 6857
)	
Entitled: METHOD FOR DETECTING)	Examiner: GITOMER, RALPH J
TRANSFERASE ENZYMATIC ACTIVITY)	

PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FILED
UNDER 37 C.F.R. § 1.705(b)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The applicant petitions for adjustment of the Patent Term Adjustment ("PTA") of U.S. Patent Application No. 10/655,878. The applicant submits that adjustments under 35 U.S.C. § 154(b)(1)(A) ("A delays") and 35 U.S.C. § 154(b)(1)(B) ("B delays") have not been properly accorded pursuant to 35 USC § 154(b)(2)(A). As a result, the applicant is being denied a portion of patent term to which it is entitled. Specifically, the applicant submits it is entitled to 1069 days of PTA, not the 408 days as calculated by the Patent Office.

Under 35 USC § 154(b), a patent is entitled to additional patent term (i.e., PTA) equal to Patent Office delays in examination minus patent applicant prosecution delays (35 USC § 154(b)(2)(C)).

In arriving at the PTA, the applicant submits that the Office has incorrectly interpreted 35 USC § 154(b)(2)(A), resulting in an incorrect figure for the Patent Office delay. Under the Patent Office's interpretation, the Patent Office delay is the longer of the A and B delays. But following *Wyeth v. Dudas*, 580 F. Supp. 2d 138 (D.D.C. Sept 30, 2008), the Patent Office delay is the sum of the A and B delays minus the number of overlapping days.

Turning to the present case, the A delay is 570 days for three Office delays:

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1. 494 days for issuing a first action under 35 U.S.C. § 132 at 14 months and 465 days after the filing date of the '878 application (37 CFR § 1.703(a)(1));
2. 4 days for issuing an action under 35 U.S.C. § 132 on April 1, 2008, at 4 months and 4 days after Applicant's November 28, 2007 reply (37 CFR § 1.703(a)(2)); and
3. 72 days for issuing an action under 35 U.S.C. § 132 on August 20, 2009, at 4 months and 72 days after Applicant's February 9, 2009 reply (37 CFR § 1.703(a)(2)).

The B delay is the number of days an application was pending beyond 3 years from the filing date, not including any time after a request for continuing examination is filed. 35 U.S.C. § 154(b)(1)(B)(i). So, the B delay is the period from September 6, 2006, until a request for continued examination was filed on July 1, 2008, or 665 days.

The applicant's delay is 162 days for four delay periods:

1. 61 days for filing a response to the Office Action mailed on June 14, 2006, at 3 months and 61 days after the mailing date (37 CFR § 1.704(b));
2. 33 days for filing a response to the Office Action mailed on July 26, 2007, at 3 months and 33 days after the mailing date (37 CFR § 1.704(b));
3. 33 days for filing a response to the Office Action mailed on October 7, 2008, at 3 months and 33 days after the mailing date (37 CFR § 1.704(b)); and
4. 35 days for filing an Information Disclosure Statement on May 19, 2006, at 35 days after filing a response to an office action on April 14, 2006 (37 CFR § 1.704(c)(8)).

As noted above, the applicant also submits that the Patent Office has construed 35 USC § 154(b)(2)(A) incorrectly. Following the *Wyeth* decision, the Patent Office delay is the sum of the A delays and B delays minus the number of days each of these periods occur on the same calendar day.

In the present case, the A and B periods overlap on four calendar days (March 29, 2008 through April 1, 2008). Thus, the proper PTA is 570 (A delay) + 665 (B delay) - 4 (overlap of A

and B periods) – 162 (applicant delay) = 1069 days, not 408 days as calculated by the Patent Office.

The '878 application is subject to a terminal disclaimer with respect to the terminal portion of the statutory term which would extend beyond the expiration date of the full statutory term of prior patent No. 7,083,911 as the term of the '911 patent is defined in 35 U.S.C. §§ 154 and 173.

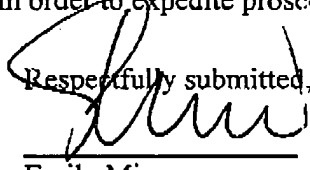
Conclusion

For all the reasons stated above, the applicant respectfully submits that the proper PTA is 1069 days and requests appropriate correction.

Fee Authorization: The Commissioner is authorized to charge the cost of any fees that may be associated with the filing of this Petition to Deposit Account No. 13-2490.

If there are any questions or comments regarding this application, the Office is encouraged to contact the undersigned in order to expedite prosecution.

Respectfully submitted,



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Date: October 13, 2009

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